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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,505	08/06/2008	Kenny Freitag	CPG 03-56 PM	6583

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MEADWESTVACO CORPORATION
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1021 Main Campus Drive
Raleigh, NC 27606

EXAMINER

FIDEI, DAVID

ART UNIT	PAPER NUMBER
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3728

NOTIFICATION DATE	DELIVERY MODE
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10/01/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketadministrator@mwv.com

Office Action Summary	Application No. 10/598,505	Applicant(s) FREITAG ET AL.	
	Examiner David T. Fidei	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/4/08</u> . | 6) <input type="checkbox"/> Other: ____. |

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Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 the terms "the radial outermost edge", "the radial inside surface" and "the corresponding arcuate segments"; have insufficient antecedent basis for these limitations. Also the term "its" located before central aperture is indefinite.

In claim 5, "the upper, outer peripheral edges" has no antecedent basis.

In claim 6, "the peripheral edges" has no antecedent basis and the it is unclear what "thereof" refers too.

In claim 9, "the radial outermost edge" has no antecedent basis. Also, the term "its" or "it" is indefinite.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Rayford Unlimited (GB 2 243 145, cited by Applicant). There is disclosed an enclosure (10) for securing and storing at least one disc-shaped element (CD) having a central aperture therein, said

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enclosure comprising: a substantially planar base (12) having a first area for receiving a centrally apertured disc-shaped element; a substantially planar cover; a spine panel (16) pivotably connecting said base and cover for allowing the base and cover to pivot between enclosure open and closed positions; a two part rosette for securing said at least one disc-shaped element in said enclosure, said rosette including; a first part centered in said area on said base, said first part comprising at least two upstanding, circularly spaced apart segments(20, 22, 24) having arcuate outer peripheral surfaces dimensioned for engaging the central aperture of a disc-shaped element at circularly spaced apart positions around its central aperture; a second part attached to said cover, said second part comprising at least two elongate, upstanding ribs (31, 33, 35) extending radially from a position on said cover which is centered on said area of said base, the number of ribs on said cover corresponding to the number of segments on said base, the ribs being positioned and dimensioned such that, when the enclosure is closed, the ribs on the cover enter said first part radially inwardly of said segments on said first part with the radial outermost edge of each of the ribs contacting the radially inside surface of the corresponding arcuate segments for biasing the arcuate segments radially outwardly (see page 5, second paragraph) to better retain a disc-shaped element when it is mounted on said arcuate segments in said first area.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Huber (US 2002/0112976). The difference between the claimed subject matter and Rayford Unlimited resides in the segments and ribs mounted on a raised central hub. Huber teaches a disc hub retainer where a means for holding a disc is mounted on a raised portion (14, see figure 13) as is well known in the art. It would have been obvious to one of ordinary skill in the art to modify the container of Rayford Unlimited by constructing the means for gripping the contents mounted on a raised hub as taught by Huber, for the reason that such a modification would have been a substitution of known elements (a raised hub instead of rings 17, 19 of Rayford Unlimited) for maintaining the disc in spaced apart relationship to the flat surfaces of the enclosure.

As to claim 5, Huber also teaches protrusions (26) extending radially outward from disc segments (13) to retain the disc central aperture (see figure 4).

8. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rayford Unlimited as applied to claim 1 above, and further in view of Iandoli et al (US 2003/0019771). The difference between the claimed subject matter and Rayford Unlimited resides in the first

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area defined by a rim raising from the base and having a diameter slightly larger than the diameter of the disc element. Iandoli et al discloses a rim (32) extending from a base panel to support the outer diameter of a disc (see paragraph [0024]). It would have been obvious to one of ordinary skill in the art to modify the enclosure of Rayford Unlimited by constructing a rim as taught by , in order to hold the outer edge of the disc and add further support to retain the disc within the enclosure.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rayford Unlimited as applied to claim 1 above, and further in view of Sankey et al (US 6,540,074). Sankey et al teaches a hinged enclosure including a base (3) provided with a C-shaped member (36, see figure 9A) and a lid closure (2) provide with a male part (35, see figure 9B) so that the parts may engage with one another with a snap fit (see col. 5, lines 39-40). To provide the enclosure of Rayford Unlimited having the marginal rims with such a structure as taught by Sankey et al would have been obvious for the reason of providing a releasable securement of cover to the base.

Allowable Subject Matter

10. Claims 9-16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. The examiner can normally be reached on Monday - Friday 8:30 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David T. Fidei/

Primary Examiner, Art Unit 3728